

## REMARKS

Claims 1-36 remain pending in this application.

Independent claims 1, 10, 19, 28, 31, and 34 have been amended to clarify that the annotation is displayed in the electronic image. Claims 3, 12, 21, 29, 32, and 35 have been amended to recite the source (i.e., the searchable electronic database) of the dragged and dropped annotation. The other amendments presented above address formalities and informalities raised in the Office Action, and are not intended or believed to affect the scope of the claims. Accordingly, approval and entry are respectfully requested.

### *Claim Rejections -- 35 U.S.C. § 112*

Claims 31-33 have been rejected under 35 U.S.C. § 112, second paragraph.

Applicant respectfully traverses this rejection.

Claims 31-33 are directed to a collection of electronic images each stored in a database of images and displayed at the request of a user. As now more clearly recited in claim 31, the images or collections of images are searchable in such a manner as to permit, in response to a user's request, their display with an annotation. Thus, the claims recite the organizational characteristics of the electronic images, not process steps. (Although not rejected on this ground, claim 28 and 34 have been amended in a similar manner to address the Examiner's concerns.)

Applicant respectfully submits that all active claims are in full compliance with Section 112. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### ***Claim Rejections -- 35 U.S.C. § 101***

Claims 1-9 have been rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1-9 have been amended to place them in method format more acceptable to U.S. patent practice. Applicant respectfully requests withdrawal of the rejection.

### ***Claim Objections***

The objection to claim 2 has been addressed above. Applicant respectfully requests withdrawal of this objection.

### ***Claim Rejections -- 35 U.S.C. § 103***

Claims 1, 2, 4-6, 10, 11, 13-15, 19, 20, 22-24, 28, 30, 31, 33, 34, and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,751,286 to Barber et al. (hereinafter "Barber").

This rejection is respectfully traversed.

Applicant respectfully submits that Barber fails to disclose or reasonably suggest the combination of features set forth in the independent claims of the subject application. The inventions as defined in claim 1 is directed to computer software-mediated method for annotating an image aspect of an electronic image. The method of claim 1 comprises a step of associating a searchable database annotation with an image aspect of a displayed image. As set forth in claim 1, the "annotation" is displayed positioned in the electronic image to permit the user to identify the associated image aspect of the displayed image. For example, if the displayed image depicts four (4) people, the annotation might

comprise a name of one of the people positioned to permit identification of the person. As further set forth in claim 1, the annotation association is stored in a second searchable electronic database so as to permit a user to retrieve said electronic image by querying the second electronic database for the annotation.

Barber concerns a method of image retrieval in which a user queries a database or images. The image query usually relates to an image characteristic. In one embodiment, one uses a “drag and drop” interface to select image aspects that are then used to query the databases. For example, in order to identify an image such as bears in water, one would select a bear’s image and a water image and drag them into an example image. Although the Barber process may permit querying of images, it is substantially different from the claimed invention. With regard to claim 1, for example, Barber fails to display an annotation positioned in an electronic image. As a consequence, Barber does not allow for differentiation between different image aspects of a single electronic image in the way contemplated by embodiments of the present invention. Further, because Barber does not teach or reasonably suggest annotations positioned in an electronic image, Barber is therefore lacking of a searchable electronic database of annotations positioned in the electronic image.

Claims 2 and 4-6 depend from claim 1, and include all of the distinguishing features thereof.

Applicant respectfully submits that Barber fails to disclose or reasonably suggest the combination of features set forth in claim 10. Like claim 1, claim 10 recites a computer software mediated method in which an annotation is displayed in an electronic image in such a manner as to be associated with an image aspect. In contrast, Barber

does not display annotations in electronic images as contemplated by embodiments of the invention. As a consequence, Barber does not allow for the possibility of differentiating between different image aspects of a single electronic image in the manner contemplated by embodiments of the present invention.

Claims 11 and 13-15 depend from claim 10 and include all of the distinguishing features thereof.

Claim 19 recites similar language as claim 10, except for permitting querying and retrieving based on image aspects that are associated with an annotation or a related family of annotations. Applicant respectfully submits that claim 19 and claims 20 and 22-24, which depend from claim 19, are distinguishable from Barber for all of the reasons advanced above with regard to claim 10.

Claim 28 is directed to an electronic image stored in a database of images and displayed at the request of a user. The image contains a desired image aspect associated with an annotation displayed in the electronic image. In response to a user's request, said image can be displayed with the annotation on the electronic image such that the position of the annotation in the electronic image permits the user to identify the associated image aspect.

As explained above, Barber discloses an image query program in which annotations are not displayed in the electronic image and are not associated with image features to permit the user to identify the associated image aspect in the manner contemplated by embodiments of the present invention.

Claim 30 depends from claim 28 and includes the distinguishing features thereof.

Claim 31 recites similar language as claim 28, except for stating that the images each contain a desired image aspect or related family of image aspects associated with an annotation or related family of annotations displayed in the electronic image. Applicant respectfully submits that claim 31 and claim 33, which depends from claim 31, are distinguishable from Barber for all of the reasons advanced above with regard to claim 28.

Claim 34 is similar to claim 31, but is directed to a computer system. Applicant respectfully submits that claim 34 and claim 36, which depends therefrom, are distinguishable from Barber for all of the reasons advanced above with regard to claims 31.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103 rejection of claims 1, 2, 4-6, 10, 11, 13-15, 19, 20, 22-24, 28, 30, 31, 33, 34, and 36.

Claims 3, 12, 21, 29, 32, and 35 have been rejected under Section 103 as being unpatentable over Barber in view of U.S. Patent No. 5,751,286 to Whayne et al. (hereinafter “Whayne”).

Applicant respectfully traverses this rejection.

Claims 3, 12, 21, 29, 32, and 35 depend from claims 1, 10, 19, 28, 31, and 34, respectively. As explained in detail above, Barber fails to disclose or reasonably suggest all of the features of these independent claims. For example, Barber fails to display an annotation positioned in an electronic image. As a consequence, Barber does not allow for differentiation between different image aspects of a single electronic image in the way contemplated by embodiments of the present invention. Further, Barber neither teaches

nor reasonably suggests a searchable electronic database of annotations positioned in the electronic image, as recited in at least some of the claims.

Whayne discloses the use of markers at column 24, lines 15-67. However, unlike the present invention, there is no indication in Whayne that these markers form the basis of a searchable database. For this reason alone, the Section 103 rejection should be withdrawn.

Additionally, Applicant respectfully submits that Whayne fails to teach or reasonably suggest the additional features of claims 3, 12, 21, 29, 32, and 35. These dependent claims recite that the annotation is selected, dragged, and dropped from a searchable electronic database to a user-selected location in the displayed electronic image. Whayne, on the other hand, discloses an editable comments field 408 in which the operator may enter a desired comment into the comment window 406 using keyboard 40. (Col. 24, lines 40-43) Once this comment window 406 has been created, MOVE MARKERS button 398 allows the user to drag and drop a selected marker 404 and associated comment window 406 to a different location on the image. (Col. 24, lines 55-58) Unlike the present invention as set forth in the dependent claims, Whayne does not select and drag annotations from a searchable electronic database.

For these additional reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103(a) rejection of claims 3, 12, 21, 29, 32, and 35.

Claims 7-9, 16-18, and 25-27 have been rejected under Section 103 as being unpatentable over Barber in view of Kuchinsky et al., FotoFile (hereinafter “Kuchinsky”).

Applicant respectfully traverses this rejection.

Claims 7-9 depend from claim 1. Claims 16-18 and 25-27 depend from claims 10 and 19, respectively. Applicant has established above that Barber fails to render claims 1, 10, and 19 unpatentable. The secondary documents Kuchinsky and FotoFile, which have been cited for their alleged disclosure of photograph labeling, do not overcome the deficiencies of Barber. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

In view of the foregoing, Applicant respectfully submits that the pending claims are allowable and that the application is in condition for allowance. Reconsideration of the application in view of this response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule same.

This Response is being filed within three months of the date of the Office Action. Accordingly, neither a petition for extension of time nor a petition fee has been concurrently filed. If any fees are due in connection with the filing of this response, please charge Deposit Account No. 50-0548 and accept this paper as a petition for extension.

Respectfully submitted,



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